

Appl. No. : 09/816,763
Filed : March 23, 2001

SUMMARY OF INTERVIEW

Exhibits and/or Demonstrations

None

Identification of Claims Discussed

Claim 1

Identification of Prior Art Discussed

Peterson et al. (US 5,563,036).

Proposed Amendments

The Applicant proposed amending Claim 1 to specify that the claimed method is for screening and/or quantification of activated transcriptional factors.

Principal Arguments and Other Matters

Applicant's representative, Dan Hart, argued that Peterson et al. (5,563,036) describe assays for screening for drugs which interfere with sequence-specific protein-DNA binding. Many transcriptional factors bind to DNA in both the active and inactive form and there is no teaching or suggestion in Peterson of identifying and/or quantifying a signal specific for the binding of activated transcriptional factors. Rather than detecting the activation state of the transcriptional factors, Peterson is directed to assessing the ability of a candidate drug to affect the degree to which a labeled transcriptional factor binds to its cognate sequence.

Results of Interview

The Examiner acknowledged that the proposed claim amendments would overcome the obviousness rejection over Peterson reference.

Appl. No. : 09/816,763
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REMARKS

Applicant wishes to thank the Examiner for extending the courtesy of granting a personal interview to Dan Hart and Nathalie Zammattéo on April 16, 2007. Claims 1, 4-8, 16, 18, 19, 21, and 37 have been amended. New Claims 39 and 40 have been added. Support for the amendments and the new claims can be found in the Specification as filed, for example on page 14, line 33 through page 15, line 4, page 15, lines 18-33, and page 26, line 18. No new matter has been introduced by these amendments. The following addresses the substance of the Office Action.

Priority

The Examiner alleged that the Applicants had not filed a certified copy of the priority document and requested to submit such a document or evidence that such document was filed previously. Applicants provide herein a copy of the application post card mailed September 21, 2001 which was stamped by the US PTO on October 1, 2001, that lists among the submitted documents a certified copy of the priority document, European Application #00870057.7. Furthermore, the Office Actions dated June 29, 2004 and January 7, 2005 both acknowledge that "All certified copies of the priority documents have been received."

However, as a courtesy, Applicants now resubmit another certified copy of the priority document.

Claim objections

The Examiner has maintained the objection of Claims 19-21 as allegedly drawn to a separate invention, which cannot be practiced together with the elected invention. Applicants respectfully disagree. The method of the currently amended Claim 1 is a method of screening and/or quantification of one or more activated transcriptional factors present in a cell or cell lysate. Claims 19 and 20 specify the step of activating the transcriptional factors by candidate compounds in the cells or cell lysates prior to the step of putting the activated transcriptional factors with the DNA sequences bound to an insoluble solid support. Claim 21 further specifies that step (c) comprises the step of identifying transcriptional factor(s) and/or peptides which are part of the transcriptional factor(s) active complex. Therefore, Claims 19-21 are properly dependent on Claim 1, and their objection should be withdrawn.

Appl. No. : 09/816,763
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Non-obviousness

The Examiner has maintained the rejection of Claims 1, 2, 4-8, 12-18, 22, 36 and 37 under 35 USC §103(a) as being allegedly unpatentable over Peterson et al. (US 5,563,036) in view of Heslot et al. (US 6,342,353) and Nerenberg et al. (US 2002/0015198). Specifically, the Examiner has maintained that it would have been obvious at the time the invention was made to a person with an ordinary skill in the art to modify the teachings of Peterson et al. with that of Heslot et al. and Nerenberg et al. to arrive at the claimed invention.

However, as the Examiner agreed during the interview, none of the cited references teach or suggest identifying and/or quantifying a signal specific for the binding of activated transcriptional factors. As discussed above, many transcriptional factors bind to DNA in both the active and inactive form and there is no teaching or suggestion in Peterson of identifying and/or quantifying a signal specific for the binding of activated transcriptional factors. Rather than detecting the activation state of the transcriptional factors, Peterson is directed to assessing the ability of a candidate drug to affect the degree to which a labeled transcriptional factor binds to its cognate sequence.

Heslot et al. and Nerenberg et al. do not cure this deficiency of the main reference. Therefore, Claims 1, 2, 4-8, 12-18, 22, 36 and 37 as currently amended are not obvious of the cited references, and their the rejection under 35 USC §(a) should be withdrawn.

The Examiner has maintained the rejection of Claim 34 under 35 USC §103(a) as being allegedly unpatentable over Peterson et al. (US 5,563,036) in view of Heslot et al. (US 6,342,353) and Nerenberg et al. (US 2002/0015198), and further in view of Dattagupta et al. (US 4,968,602).

Claim 12 depends from Claim 1, which is asserted to be non obvious over the Peterson et al. in view of Heslot et al. and Nerenberg et al. Dattagupta fails to cure the deficiencies of these references. Therefore, Claim 12 is also non-obvious over the cited references, and its rejection under 35 USC §103(a) should also be withdrawn.

Double Patenting

The Patent Office has maintained the rejection of claims 1, 2, 4-8, 12-18, 22, 34, 36 and 37 on the grounds of obviousness-type double patenting over claims 1-21, 25 and 26 of copending Application No. 10/821,568. A terminal disclaimer may be used to overcome an

Appl. No. : 09/816,763
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obviousness-type double patenting rejection. Applicant will defer filing a terminal disclaimer until the rejected claims are otherwise indicated to be in condition for allowance.

CONCLUSION

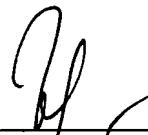
Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 24, 2004

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AMEND

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